



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Donald R. Youell, Jr., et al.
Serial No. : 09/865,229
Filed: : May 25, 2001
For: : Automobile Part Shipping System and Method
TC/AU : 3700
Examiner : Paul R. Durand
Attorney Docket No. : ACP 2-021-1

MAIL STOP APPEAL BRIEF-PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

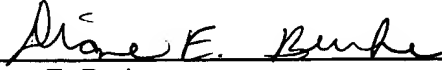
APPELLANTS' BRIEF ON APPEAL

Sir:

Responsive to an Office action mailed November 10, 2005, Appellants filed a Notice of Appeal on May 9, 2006. Submitted herewith is Appellant's Brief on Appeal as prescribed in 37 C.F.R. § 41.31. The patentee respectfully requests reversal of the primary examiner's rejection of the appealed claims and confirmation of the appealed claims patentability.

The requisite fee of \$250.00 as required in 37 C.F.R. § 41.20(b)(2) is submitted herewith. Also submitted herewith is a request for a 1 month extension of time up to and including August 9, 2006. Any additional payments that may be required should be charged to Deposit Account No. 13-4830.

Respectfully submitted,


Diane E. Burke
Reg. No. 45,725
MUELLER AND SMITH, L.P.A.
MUELLER-SMITH BUILDING
7700 Rivers Edge Drive
Columbus, Ohio 43235-1355
tel.: 614-436-0600
fax: 614-436-0057
email: dburke@muellersmith.com

08/09/2006 MWOLDGE1 00000031 09865229

01 FC:2402

250.00 0P



Appeal Brief

By: Donald R. Youell, Jr.

U.S. Serial No. 09/865,229

Filed May 25, 2001

"Automobile Part Shipping System and Method"

**Examiner Paul R. Durand
Technology Center 3700**

Table of Contents

Real Party in Interest	3
Related Appeals and Interferences	4
Status of Claims	5
Status of Amendments	7
Summary of Claimed Subject Matter	8
Grounds of Rejection	9
Argument	10
Claims Appendix	19
Evidence Appendix	20
Declaration under 37 C.F.R. 1.132	21
Supplemental Declaration under 37 C.F.R. 1.132	27
Related Proceedings Appendix	29

Real Party in Interest

The appealed application has not been assigned by Appellants and currently is owned by Donald R. Youell, Jr. and Rudy Youell.

Related Appeals and Interferences

There are no related appeals or interferences known to appellants, their legal representatives, or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

The appealed application was filed with claims 1-23. Claims 1-5 and 24 are the subject of this appeal. Claims 6-23 have been withdrawn.

The appealed application was filed May 25, 2001 with claims 1-23. In a first Office action mailed September 20, 2002, a four-way restriction requirement was levied. On October 1, 2002, Appellant elected with traverse Group I including claims 1-5.

In an Office action mailed October 23, 2002, the restriction requirement was made final and claims 6-23 were deemed withdrawn as being directed to the non-elected invention. Claims 1-5 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as the invention. Additionally, claims 1 and 3 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,154,898 issued to Engles, Jr. (hereinafter, "Engles, Jr."). Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles, Jr. in view of U.S. Patent No. 3,166,188 issued to Koester (hereinafter, "Koester"). Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles, Jr. in view of U.S. Patent No. 4,611,456 issued to Gillio-tos, et al. (hereinafter, "Gillio-tos, et al."). Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles, Jr. in view of U.S. Patent No. 6,010,003 issued to Wilkinson (hereinafter, "Wilkinson"). On January 23, 2003, Appellant filed a response including the amendment of claims 1, 2, 3 and 4.

In a final Office action mailed March 28, 2003, claims 1 and 3 were rejected under 35 U.S.C. §102(b) as being anticipated by Engles, Jr. Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles, Jr. Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles, Jr. in view of Gillio-tos, et al. Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles, Jr. in view of Wilkinson. On July 1, 2003, Appellant submitted an amendment and response after final proposing changes to claims 1, 3, 4, and 5.

On July 17, 2003, issued an Advisory Action indicating that the proposed amendments made after the final rejection would not be entered because they raised new issues that would require further consideration and/or search. On September 25, 2003, Appellant submitted a Request for Continuing Examination so that the Examiner would consider the Appellant's previously proposed amendment filed July 1, 2003.

At the request of the Appellant, the Examiner conducted a telephonic interview with Appellant's undersigned attorney on October 28, 2003. On October 29, 2003, the Examiner

mailed an Interview Summary indicating that no agreement had been reached at the telephonic interview.

On December 30, 2003, a non-final Office action was mailed. In that action, claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by newly cited U.S. Patent No. 3,784,004 issued to Meyer (hereinafter, "Meyer"). Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Meyer in view of Gillio-tos. Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Engles, Jr. Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Wilkinson.

On July 8, 2004 Appellant filed an amendment and response with a Declaration under 37 C.F.R. 1.132 along with a petition to revive as the application had been inadvertently abandoned. With this response, Appellant amended claim 1. The petition to revive was granted September 20, 2004.

In a final action mailed March 4, 2005, claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Meyer. Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Meyer in view of Gillio-tos. Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Engles, Jr. Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer and Engles, Jr. in further view of newly cited U.S. Patent No. 3,618,755 issued to Kean. Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Wilkinson.

September 6, 2005, Appellant submitted a Request for Continued Examination along with an amendment and response, which amended claim 1 and added a new claim 24. Included with the response was a Supplemental Declaration under 37 C.F.R. 1.132.

In a non-final Office action mailed November 10, 2005, claims 1 and 24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Meyer. Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Meyer in view of Gillio-tos. Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Engles, Jr. Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer and Engles, Jr. in further view of newly cited U.S. Patent No. 3,618,755 issued to Kean. Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Wilkinson.

Appellant filed a Notice of Appeal May 9, 2006.

Status of Amendments

No amendments have been filed subsequent to the final rejection of the claims.

Summary of Claimed Subject Matter

The present invention is addressed to a method for packaging a structural automobile part to decrease damage during shipment. The claimed method commences with the step of providing a paperboard having a front and a back. Claim 1, line 3 and Figs. 1, 4 and 11. "Paperboard" is corrugated paper, an oft-used product in the shipping container and carton industry. Application, page 3, lines 3-4. The structural automobile part then is placed on the front of the paperboard leaving exposed areas on the front of the paperboard. Claim 1, lines 4-5 and Figs. 4 and 11. The method concludes by shrink-wrapping the structural automobile part to the paperboard and exposed areas of the paperboard with plastic shrink wrap material, such that damage to the structural automobile part is decreased during shipping. Claim 1, lines 6-8 and Figs. 4 and 11.

A "structural automobile part" is defined in the specification as being a large and heavy automobile part, which may be unbreakable or breakable. Application, page 4, lines 7-19. Examples of unbreakable structural automobile parts are hoods, fenders, doors, and the like. Breakable may be, for example, automobile windshields. *Id.* Whether breakable or unbreakable, these parts generally are difficult to ship because they are bulky yet easily damaged (i.e., scratched, dented, broken, etc.). *Id.* Such parts may weigh upwards of several hundred pounds. *Id.* The surprisingly simple, claimed method protects objects from breaking, scratching, denting, abrading, etc., thus, decreasing damage during shipping.

Grounds of Rejection to be Reviewed on Appeal

Whether claims 1 and 24 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Meyer.

Whether claim 2 is unpatentable under 35 U.S.C. §103(a) over Meyer in view of Gilliotos, et al.

Whether claim 3 was rejected under 35 U.S.C. § 103(a) over Meyer in view of Engles, Jr.

Whether claim 4 is unpatentable under 35 U.S.C. § 103(a) over Meyer and Engles, Jr. in further view of Kean.

Whether claim 5 is unpatentable under 35 U.S.C. § 103(a) over Meyer in view of Wilkinson.

Argument

I. Claims 1 and 24 are not anticipated by Meyer under 35 U.S.C. § 102(b)

Claim 1

Claim 1 is neither anticipated nor rendered obvious by Meyer, either alone or in combination with any of the cited references. First, Meyer does not disclose a method for packaging and shipping a structural automobile part wherein damage to said structural automobile part is decreased. Claim 1, steps (b) and (c). As such, Meyer does not disclose each and every feature of the claimed invention and cannot anticipate it. Second, Meyer's invention resides in a completely different field than that of the present invention and addresses a completely different problem. As such, Meyer is non-analogous art. Even if considered analogous art, none of the other cited references make up for Meyer's deficiencies. Also, the 132 declaration of Donald Youell establishes a long felt need in the industry, the surprising and unexpected results achieved, and the commercial success that his company has enjoyed based on the industries adoption of his invention which evidences the non-obviousness of the claimed invention.

In developing the present invention, Appellants faced the problem of packaging and shipping structural automobile parts without damage caused by unwanted tactile contact. A "structural automobile part" is defined in the specification as being a large and heavy automobile part, which may be unbreakable or breakable. Application, page 4, lines 7-19. Examples of unbreakable structural automobile parts are hoods, fenders, doors, and the like. Breakable may be, for example, automobile windshields. *Id.* Whether breakable or unbreakable, these parts generally are difficult to ship because they are bulky yet easily damaged (i.e., scratched, dented, broken, etc.). *Id.* Such parts may weigh upwards of several hundred pounds. *Id.* Because of their size, shape, and weight, packaging structural automobile parts for shipping without damage presents a unique problem not encountered by other packaging methods. The Examiner has stated that a structural automobile part is "a part having structure." November 10, 2005 Office action, page 4. The claims are to be read as broadly as possible, but such construction must be within the bounds of the specification. In view of the application citations provided above, the Examiner's construction clearly is overly broad and beyond the scope of the specification.

Unwanted contact during shipping may be an impact, for example, when a part is dropped. Tactile contact also may occur when heavy objects are placed on top of the packaged part, leading to bowing or other deformation. Unwanted tactile contact causes two categories of

damage during shipment. Certain parts, such as windshields, are susceptible to breakage. Other parts, such as fenders, hoods, doors, etc., are not likely to break but may be dented, scratched or otherwise abraded. Another problem associated with shipping all structural automobile parts is their relatively large size, awkward shape, and heavy weight. These problems are set forth at page 4 of the present application, which states that:

Of similar importance is the prevention of the object being shipped from moving, shifting, or otherwise changing position during loading, shipping, and storage of the object. Smaller objects, even delicate and breakable objects, are easier to pack for shipment because of their small size. When the object is large and heavy, such as an automobile structural part, proper packing for its safe shipment is anything but routine. Even "unbreakable" structural automobile parts, such as hoods, fenders, and doors, can become scratched, dented, and abraded to the point that rework of the part is needed. When the structural automobile parts are breakable and non-planar, such as automobile windshield glass, the packing problems become even more compounded. Now, the packer must be attentive to scratching, abrading, breaking, and stress, of a part that can weigh upwards to several hundred pounds. A daunting task for the part manufacturer and shipper indeed.

Appellants' invention contemplates a single packaging method that addresses all of these problems. This is true regardless of whether the structural automobile part is a windshield or it is a fender, door or hood. This also is true regardless of whether the damage is breakage, denting, scratching, etc. See, Present Application at page 7.

What's missing from Meyer's disclosure is the packaging of a specific product, namely a structural automobile part, to prevent damage during shipping. Instead what Meyer teaches is airtight packaging of products, namely food, to prevent staleness, dehydration, corrosion, etc.

Specifically, Meyer is directed to packaging "to prevent entry and exit of moisture through the substrate into the chamber in which the article is encased." Col. 1, lines 7-9. This is stated over and over again throughout the patent. See Col. 1, lines 18-20 ("to prevent entry of air or moisture through the substrate into the chamber in which the article is encased"); Col. 1, lines 26-28 ("which prevents passage of moisture and air into and out of the chamber through said substrate so as to substantially hermetically seal said article in the chamber"); Col. 2, lines 22-28 (For instance, it would be desirable to achieve prevention of moisture entry into the chamber having the encased article so as to prevent or minimize corrosion effects on the article or to prevent escape of moisture where bakery goods are packaged so as to eliminate staleness and dehydration of the goods."); Col. 2, lines 50-55 ("The portion of the substrate contacted by and below the article remains non-porous by reason of the unmelted coating forming a vapor protection barrier which prevents passage of air into the chamber having the article encased therein."); Col. 2, line 66 to Col. 3, line 5 ("The invention also provides a novel

skin package having a barrier protection coating on the otherwise porous substrate subtending the article encased in a vacuum-formed plastic film chamber which prevents passage of air or moisture through the otherwise porous substrate subtending said article and relative to said chamber.”); Col. 4, lines 36-39 (“In this manner, the substrate having coating 20A remains non-porous and thereby hermetically seals the mouth 23 to chamber 18 with the article 14 therein.”); Col. 4, lines 57-61 (“The coating material selected has the property of remaining solid at ordinary room temperatures so that it can function as a moisture-barrier protective coating on an otherwise porous substrate or base pad.”); Col. 5, lines 39-49 (“When packaging metal products such as bearings, clutches, or various automobile or mechanical parts, the barrier coating 20A provides corrosion protection by preventing moisture entering the chamber 18. It is contemplated that corrosion-inhibiting products can be added to the chamber 18 to obtain a long-lasting anti-corrosion package. The barrier coating 20A in cooperation with the substrate 12 supporting same closes the mouth 23 to the chamber 18 to prevent moisture or air from entering the chamber.”); and Col. 5, lines 60-64 (“Actual tests of the skin package embodying the invention... have enabled frozen meat or poultry to be skin packaged for four to six weeks without dehydration.”).

☺ Bearings, clutches, etc. are not structural automobile parts as defined in the specification of the present application. Meyer’s disclosure also lacks any teaching or suggestion that laminating an automobile windshield or fender to paperboard would decrease damage to these items during shipping. The fact that claim 1 is directed to packaging for shipment is extremely important. It defines the what capabilities the packaging must have. For example, the requirements for decorative packaging, like gift wrapping, are not the same as for storage packaging. Likewise, the packaging requirements for storage are not the same as for shipping. Step (c) of claim 1 stresses this point. The packaging must be able to prevent damage during shipment.

Meyer does not disclose a method for packaging an automobile part for shipment. Neither the word “ship” nor “shipping” appear anywhere in Meyer. Meyer is strictly directed to packaging for storage. There is no teaching or suggestion that Meyer’s packaging would be capable of protecting its article from damage of the type described above, e.g., breaking, denting, scratching, etc. The words damage, break, dent, abrade also do not appear anywhere in Meyer. In order to anticipate a claim, a reference must include each and every claim limitation. Meyer clearly does not anticipate the claimed invention because it does not include the above-described damage prevention feature of the invention.

Claim 1 also is not obvious in view of Meyer. Meyer is non-analogous art and, therefore, the skilled artisan would not look to it when confronted with the present problem. To determine

whether a reference is analogous art, one must consider whether 1) the reference is within the field of the inventor's endeavor and 2) the reference is reasonably pertinent to the particular problem with which the inventor was involved. Neither of these is true with respect to Meyer and the present invention.

As indicated in Mr. Youell's 132 declarations, he has been involved in the manufacture and design of corrugated packaging for 45 years. Declaration under 37 C.F.R. § 1.132, ¶ 2. He was a principal in the formation of two successful packaging companies. Declaration under 37 C.F.R. § 1.132, ¶ 5. He also is an inventor on two patents addressed to inventions in the packaging field. Declaration under 37 C.F.R. § 1.132, ¶¶ 3 and 4. As such, he can attest to whether or not the skilled artisan would consult Meyer to solve the problem at hand. In fact, the skilled artisan would not consider Meyer relevant art.

First, Meyer is not within the field of the inventor's endeavor. Meyer is in the field of article preservation. He is concerned with preventing the degradation of articles, primarily food, caused by the passage of air or moisture through a conventional porous substrate. Supplemental Declaration under 37 C.F.R. § 1.132, ¶ 2. On the other hand, the present invention is in the field of structural automobile shipment. *Id.* at 6.

Second, Meyer is not reasonably pertinent to the particular problem with which the inventor is involved. As noted above, Meyer poses the problem of making a skin packaging utilizing a conventional porous substrate impervious to the passage of air or moisture therethrough. *Id.* Meyer identifies that, where the packaged article is food, passage of air and moisture from the packaging may cause damage in the form of staleness or dehydration. *Id.* at ¶ 3. Exposure of a packaged article to air and moisture may cause damage in the form of corrosion *Id.* at ¶ 4. Meyer solved these problems by applying one or more coatings, such as a low melting point barrier coating, to the porous substrate in order to prevent air or moisture from escaping or entering the packaging. *Id.* at ¶ 5.

Appellants, on the other hand, faced the problem of reducing physical damage to structural automobile parts caused by the unwanted tactile contact, such as an impact, of an object against the structural automobile part during shipping. *Id.* at ¶ 6. Unwanted tactile impact to structural automobile parts formed primarily of glass, such as windshields, causes physical damage in the form of breakage. *Id.* at 7. For structural automobile parts formed of metal, such as hoods and fenders, unwanted tactile impact causes physical damage in the form of scratching and/or denting. *Id.* at ¶ 8. There is no teaching or suggestion that the packaging disclosed in Meyer could protect windshields from breaking, fenders from denting, or hoods from scratching. With respect to metal parts, specifically "bearings, clutches, or various automobile or mechanical parts," Meyer teaches only how to package such parts to prevent

corrosion. See Col. 5, lines 39-49. Further, it is error to define the problem in terms of its solution. To do so is improper hindsight. Stated another way, just because the final solutions are similar does not mean that the problems were the same. Meyer simply is not reasonably pertinent to the problem faced by Appellants. Mr. Youell, having over 45 years of experience in the field of packaging and shipping, affirmatively states that the skilled artisan would not look to Meyer or any other reference dealing with the presence or absence of air or moisture to solve the problem of shipping structural automobile parts without damage. *Id.* at 9.

Because it is not reasonably pertinent to Appellants' particular problem and is not in the field of Appellants' endeavor, Meyer is non-analogous art and cannot render the claimed invention obvious. Even assuming, *arguendo*, that Meyer is analogous art, none of the other cited references make up for the deficiencies of Meyer. Specifically, none of the reference disclose the packaging of structural automobile parts using the proposed laminate process to decrease damage during shipping.

Mr. Youell's 132 declarations also evidence the non-obviousness of the claimed method. Mr. Youell is president of American Corrugated Products (ACP), which manufactures and sells packaging to be used in accordance with the claimed methods. Since the packaging was introduced, ACP has experienced phenomenal commercial success. ACP's customers include, among others, Daimler Chrysler and Mac-Pack. As Mr. Youell's declaration indicates, the breakage rate for laminated glass products is traditionally high in a single pack application. However, with the ACP design, Mr. Youell's customer, Daimler Chrysler, has reported to him that breakage is down considerably and they are able to ship more single packs to customers with the confidence that the parts will arrive intact. ACP's unique design completely protects the sealing surfaces from damage and is the only packaging that Daimler Chrysler has seen that offers that ability.

Another of ACP's customer's, Mac-Pack Services, Inc., has reported to Mr. Youell that, historically, the glass packing portion of the business has resulted in a high percentage of damaged and broken glass during the shipping phase. Since Mac-Pack Services has been a customer of American Corrugated Products, the claims for broken and damaged shipments has decreased by 90%. Mac-Pack Services, Inc. also reported to Mr. Youell that use of the ACP design has been so successful that Mac-Pack Services' business with automotive companies and glass manufacturers has increased 300%.

Several objections have been raised with respect to Mr. Youell's original 132 declaration. In particular, the Examiner states that no factual evidence has been provided for paragraphs 11, 12, 17 and 18 of the declaration. These paragraphs deal with the decreased breakage rates experienced by Mr. Youell's customers and set forth Mr. Youell's increased sales. Appellants

first would note that, in his declaration, Mr. Youell is attesting under penalty of perjury to what his customers have reported to him on the benefits of the invention. The letters submitted with his declaration are intended merely to provide additional support for his statements. Such letters, maintained by Mr. Youell in the ordinary course of business, are an exception to federal courts' hearsay rule of evidence and are proper support for Mr. Youell's declaration. Mr. Youell also is able to attest based on first hand knowledge as to the increase in sales that his company has experienced as a result of implementation of the inventive method.

Also, although his statements set forth a qualitative rather than quantitative analysis, this does not mean that his statements are not facts. Specific details regarding breakage rates are considered trade secrets in the industry. By providing the information on breakage in terms of percentages, his statements show the improvement realized without disclosing his customers or his sensitive, trade secret information.

Claim 24

Claim 24, dependent on claim 1, recites that "said damage comprises one or more of scratching, denting, breaking, abrading, and stressing." Claim 24 should be considered patentable for the reasons given in connection with claim 1. Additionally, it should be noted that the type of damage recited in claim 24 is nowhere mentioned in Meyer. Again, Meyer's primary concern is the protection of food from air and moisture. The skilled artisan would not read Meyer and learn that packaging by lamination would protect metal and glass products from scratching, denting, breaking, abrading, and stressing.

II. Claim 2 is patentable under 35 U.S.C. §103(a) over the combination of Meyer and Gillio-tos, et al.

The Examiner cites Gillio-tos, et al. as disclosing that it is old and well-known in the art to use a backing that can be comprised as a laminate as a means of increasing product durability.

Gillios-tos, et al. does not make up for the deficiencies of Meyer. Like Meyer, Gillios-tos, et al. does not disclose a packaging that is designed for "shipping said shrink-wrapped structural automobile part." Gillio-tos' packaging, like Meyer, is directed to protecting the packaged article from air and moisture. Also like Meyer, Gillio-tos, et al. does not disclose packaging for structural automobile parts. Automobile parts are nowhere mentioned in Gillio-tos, et al. and food and automobile parts clearly are not interchangeable products for packaging and shipping purposes. The combination of Meyer and Gillos-tos, et al., two patents addressed to packaging primarily for vacuum sealing food, would not have suggested to the skilled artisan that structural automobile parts could be packaged and shipped safely encased in plastic shrink wrap on

laminate paperboard. That structural automobile parts can be shipped in those materials clearly is unexpected and surprising. In the almost 20-30 years since the Meyer and Gillios-tos, et al. patents issued, no one has applied such shrinking wrapping techniques for packaging and shipping large, bulky, and/or breakable automotive items. For these reasons, claim 2 is not obvious in view of Meyer, Gillios-tos, et al., or the combination of the two.

III. Claim 3 is patentable under 35 U.S.C. § 103(a) over the combination of Meyer and Engles, Jr.

First, the combination of Engles, Jr. and Meyer is improper. Engles, Jr. specifically teaches away from the use of paperboard because of the problems associated with it. In particular, Engles, Jr. notes that paperboard backing are "not water impervious, tend to curl under stress, and require the use of an adhesive to secure a firm bond between the backing and the film overlay." Col. 1, lines 15-18. To overcome these problems, Engles, Jr. specifically rejects paperboard as an effective backing or substrate and uses foam instead. See, Col. 1, lines 19-23. When viewed as a whole, Engles, Jr. teaches that attempts to use paperboard were unsuccessful. Combining Engles, Jr. with Meyer, a patent that espouses paperboard backing, is improper given the contradictory teachings of the two references.

Even if the combination were proper, there is no suggestion in Engles, Jr. that paperboard could be used with large automotive parts, such as windshields, doors, fenders, etc. Engles, Jr. discloses the packaging of an "article". The only article specifically disclosed is a spark plug. See, Figs. 1-3 and the Examples at Col. 3, line 24-Col. 4, line 2. Thus, Engles, Jr. teaches away from paperboard even for small articles, let alone larger automotive parts. Thus, Engles, Jr. does provide the teaching that Meyer lacks.

To overcome the lack of disclosure regarding the article to be shipped, the Examiner defines a "structural automobile part" as being "a part having structure." As noted above, this construction is overly broad and not consistent with the specification. The application defines a "structural automobile part" as meaning a large and heavy automobile part, which may be unbreakable or breakable. Application, page 4, lines 7-19. Examples of unbreakable structural automobile parts are hoods, fenders, doors, and the like. Breakable may be, for example, automobile windshields. With this definition, it may be seen that Engles, Jr. does not disclose a structural automobile part.

IV. Claim 4 is patentable under 35 U.S.C. § 103(a) over Meyer and Engles, Jr. in further view of Kean.

Claim 4 further recites that "said structural automobile part is selected from the group consisting of window glass, door panel, hood, fender or combinations thereof". The Examiner states that Meyer does not explicitly disclose such automobile parts but relies on Kean as allegedly teaching "that it is old and well known in the art of shrink packaging to package glass sheets 21, such as the type found in a window, which are packaged on a corrugated paperboard panel 22 and then shrink wrapped with envelope 35 for the purpose of protecting a product during shipping." November 10, 2005 Office action, page 4.

Appellants first note that Kean illustrates the relatively complicated packaging representative of the prior art. Specifically, Kean discloses "a package for glass sheets wherein a stack of glass sheets are enclosed within a protecting case and a sealed envelope and then further contained within a substantially rigid frame which is then contained in a sealed moisture-proof envelope." Kean, Col. 1, lines 43-47. A plurality of such assemblies then are stacked together and sealed in an envelope. See Fig. 4 and the accompanying text. What Kean teaches is that large, breakable items such as window glass, require extensive packaging to avoid breakage. Thus, the combination of Meyer and Kean teaches away from the claimed invention.

It also should be noted that Kean teaches packaging together stacks of glass sheets such that the preferred total footage of glass is 50 square feet. Col. 1, lines 5-9. Packaging many sheets of glass together this way innately provides structural integrity to the resulting mass. Kean does not contemplate shipping a single sheet of glass. The present method can be used to package a plurality of articles for shipping but what is surprising and unexpected is that the claimed method imparts sufficient strength and durability so that a single sheet of glass can be packaged and shipped without breaking. As such, claim 4 should be considered patentable over Meyer, Kean and the combination of Meyer and Kean.

V. Claim 5 is patentable under 35 U.S.C. § 103(a) over Meyer and Wilkinson.

Wilkinson does not make up for the deficiencies of Meyer. It does not disclose a method for shipping structural automobile parts. Therefore, Appellants submit that claim 5 is patentable for the reasons given above in connection with claim 1.

Conclusion

Accordingly, Appellants respectfully urge the Board to overrule the rejection of the appealed claims and to permit the appealed application to pass to issue.

Respectfully submitted,

A handwritten signature in cursive script, reading "Diane E. Burke", is written over a horizontal line.

Diane E. Burke
Reg. No. 45,725
MUELLER AND SMITH, L.P.A.
Mueller-Smith Building
7700 Rivers Edge Drive
Columbus, Ohio 43235-1355
tel.: 614-436-0600
fax: 614-436-0057
email: dburke@muellersmith.com

CLAIMS APPENDIX

The Appealed Claims

Claim 1: Method for packaging an automobile part to decrease damage during shipment, which comprises the steps of:

- (a) providing a paperboard having a front and a back;
- (b) placing a structural automobile part on the front of said paperboard leaving exposed areas of said front of said paperboard; and
- (c) shrink-wrapping with plastic shrink wrap material said structural automobile part to said paperboard and said exposed areas of said front of said paperboard, wherein damage to said structural automobile part is decreased during shipping.

Claim 2: The method of claim 1, wherein said paperboard comprises laminated plies of paperboard.

Claim 3: The method of claim 1, wherein said structural automobile part is composed of material selected from the group consisting of metal, composite, glass or combinations thereof.

Claim 4: The method of claim 3, wherein said structural automobile part is selected from the group consisting of window glass, door panel, hood, fender or combinations thereof.

Claim 5: The method of claim 1, wherein said shrink-wrapped structural automobile part of step (c) is placed in a container.

Claim 24: The method of claim 1 wherein said damage comprises one or more of scratching, denting, breaking, abrading, and stressing.

EVIDENCE APPENDIX

- 1) Declaration under 37 C.F.R. 1.132, which was filed on July 8, 2004 .and entered in the Office action mailed March 4, 2005
- 2) Supplemental Declaration under 37 C.F.R. 1.132, which was filed September 6, 2005 and entered in the Office action mailed November 10, 2005.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Donald R. Youell, Jr., et al.
Serial No. : 09/865,229
Filed: : May 25, 2001
For: : Automobile Part Shipping System and Method
TC/AU : 3721
Examiner : Paul R. Durand
Attorney Docket No. : ACP 2-021

HONORABLE COMMISSIONER FOR PATENTS
MAIL STOP FEE AMENDMENT
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.132

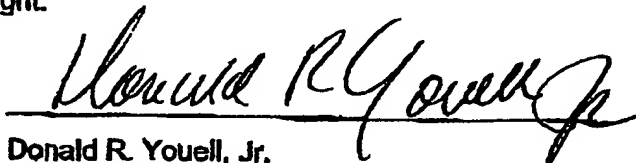
Donald R. Youell, Jr. does declare and state:

- 1) That he attended Emory & Henry College and majored in business;
- 2) That he has been involved in the manufacture and design of corrugated packaging for 45 years;
- 3) That he has invented a patented reusable self-locking carton and tray assembly, U.S. Patent No. 5,139,194;
- 4) That he is a co-inventor of a patented paperboard runner and paperboard pallets constructed therewith, U.S. Patent No. RE35131;
- 5) That he was a principal in the formation of two successful packaging companies;
- 6) That he was a finalist for the Columbus, Ohio area Small Business Person of the Year award in 1989;
- 7) That he is a co-inventor of and co-applicant on the above-identified application;
- 8) That he is president of American Corrugated Products (ACP), which manufactures and sells packaging to be used in accordance with the method of claims 1-5;
- 9) That his customers include, among others, Daimler Chrysler, Mac-Pack Services, Inc.
- 10) That Exhibit A, attached hereto, is a copy of a letter received by ACP from Richard Tracy, the purchasing agent for Daimler Chrysler;

- 11) That, as indicated by Mr. Tracy, the breakage rate for laminated glass products is traditionally high in a single pack application;
- 12) That, with the ACP design, Daimler Chrysler's breakage is down considerably and that they are able to ship more single packs to customers with the confidence that the parts will arrive intact;
- 13) That ACP's unique design completely protects the sealing surfaces from damage and is the only packaging that Mr. Tracy has seen that offers that ability;
- 14) That Exhibit B, attached hereto, is a copy of a letter that ACP received from Daniel McLaughlin, president of Mac-Pack Services, Inc.
- 15) That, as indicated by Mr. McLaughlin, Mac-Pack Services is a contract packaging company that specializes in packaging aftermarket automotive glass products;
- 16) That, historically, the glass packing portion of the business has resulted in a high percentage of damaged and broken glass during the shipping phase;
- 17) That Mac-Pack Services has been a customer of American Corrugated Products for about a year, and during that time, the claims for broken and damaged shipments has decreased by 90%;
- 18) That use of the ACP design has been so successful that Mac-Pack Services' business with automotive companies and glass manufacturers has increased 300%;
- 19) That Exhibits A and B are letters maintained by ACP in the ordinary course of business;
- 20) That the foregoing advantages emphasize the uniqueness of the shipping method of the present invention;
- 21) That he has been advised that claim 1 in the above-identified application has been rejected under 35 U.S.C. § 102 as being anticipated by Meyer, U.S. Patent No. 3,784,004;
- 22) That he has been advised that, in applying this rejection, the Examiner has cited Meyer as showing a paperboard having a front and back, placing an automobile part that has a structure on the front of the paperboard, leaving front areas exposed, and shrink wrapping the part onto the paperboard with film;
- 23) That as defined in the application at page 4, lines 7-19, a structural automobile part is a large and heavy automobile part, which may be unbreakable or breakable. Examples of unbreakable structural automobile parts are hoods,

- fenders, doors, and the like. Breakable may be, for example, automobile windshields;
- 24) That Meyer discloses packaging designed to prevent air and moisture from damaging or corroding the packaged article;
 - 25) That Meyer includes no suggestion or teaching to package and ship structural automobile parts;
 - 26) That he has been advised that the Examiner has rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Gillio-tos, U.S. Patent No. 4,611,456;
 - 27) That Gillio-tos does not disclose a method for shipping a structural automobile part;
 - 28) That he has been advised that the Examiner has rejected claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Engles, Jr., U.S. Patent No. 3,154,898;
 - 29) That for shipping purposes, window glass, door panels, hoods, and fenders are not equivalent to or interchangeable with clutches and bearings;
 - 30) That he believes that the present invention is patentable, and is not anticipated nor rendered obvious by the art combination cited in the above-identified application; and
 - 31) That all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like, so made, are punishable by fine, or imprisonment, or both, under Section 1001 of Title 18, and that such willful false statements may jeopardize the validity of the application or any document resulting therefrom.

Further Declarant sayeth naught.


Donald R. Youell, Jr.

DAIMLERCHRYSLER



DaimlerChrysler Corporation
MOPAR Procurement

March 22, 2004

To Whom It May Concern,

I am writing in regards to the American Corrugated Products skin-packaging designs for automotive glass.

As a supplier of aftermarket automotive glass products, we have the need to ship large laminated glass windshields in a single package across the United States. The breakage rate for laminated glass products is traditionally high in a single pack application.

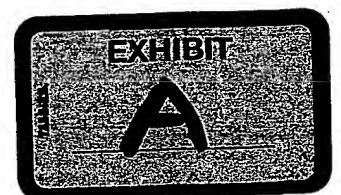
Since changing to the skin pack design, our breakage is down considerably and we are able to ship more single packs to customers with the confidence that they will arrive intact.

The unique design is extremely beneficial when shipping fully encapsulated products and glass with moldings attached. The ACP design completely protects the sealing surfaces from damage and is the only design I have seen that offers that ability.

I would highly recommend the American Corrugated Products skin packaging method for protection of laminated and tempered products.

Sincerely,

Richard Tracy
Purchasing Agent
Mopar Procurement



DaimlerChrysler Corporation
26311 Lawrence Avenue CIMS 423-11-32



MAC-PACK SERVICES, INC.

4101 FOUNDERS BLVD.

BATAVIA, OHIO 45103

513-753-7705 FAX 513-753-7748

March 25, 2004

Diane Burke:

I am writing regarding the American Corrugated Products skin pack designs.

Mac-Pack Services is a contract packing company that specializes in packaging aftermarket automotive glass products. We receive bulk glass shipments and package them individually for shipment to the end user.

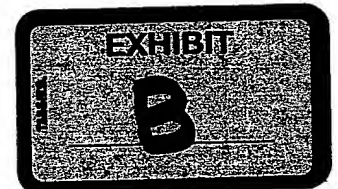
Historically the glass packing portion of our business has resulted in a high percentage of damaged and broken glass during the shipping phase. We incorporated the American Corrugated skin packing designs approximately one year ago and have since reduced claims for broken and damaged shipments by 90%.

The unique combination of skin film and corrugated substrates been so effective and successful that we have increased our business with automotive companies and glass manufactures 300%. Due to our use of this method of packaging we anticipate additional market gains in the coming year.

I would highly recommend the ACP skin packing designs for protection of tempered and laminated glass products.

Sincerely,

Daniel McLaughlin
President
Mac-Pack Services Inc.



AFTERMARKET PARTS PACKING SPECIALISTS



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Donald R. Youell, Jr., et al.
Serial No. : 09/865,229
Filed: : May 25, 2001
For: : Automobile Part Shipping System and Method
TC/AU : 3721
Examiner : Paul R. Durand
Attorney Docket No. : ACP 2-021-1

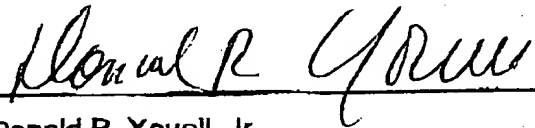
HONORABLE COMMISSIONER FOR PATENTS
MAIL STOP AMENDMENT
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

SUPPLEMENTAL DECLARATION UNDER 37 C.F.R. §1.132

Donald R. Youell, Jr. does declare and state:

- 1) That his education and experience are as set forth in his previously executed Declaration under 37 CFR §1.132;
- 2) That Meyer poses the problem of making a skin packaging utilizing a conventional porous substrate impervious to the passage of air or moisture therethrough;
- 3) That Meyer identifies that, where the packaged article is food, passage of air and moisture from the packaging may cause damage in the form of staleness or dehydration;
- 4) That Meyer identifies that exposure of a packaged article to air and moisture may cause damage in the form of corrosion;
- 5) That Meyer solved the problem identified in paragraph 2 by applying one or more coatings, such as a low melting point barrier coating, to the porous substrate in order to prevent air or moisture from escaping or entering the packaging;
- 6) That his invention addresses the problem of reducing physical damage to structural automobile parts caused by the unwanted tactile contact, such as an impact, of an object against the structural automobile part during shipping;
- 7) That unwanted tactile impact to structural automobile parts formed primarily of glass, such as windshields, causes physical damage in the form of breakage;

- 8) That unwanted tactile impact to structural automobile parts formed of metal, such as hoods and fenders, causes physical damage in the form of scratching and/or denting;
- 9) That he, as a person skilled in the art with over 45 years of experience in the field of packaging and shipping, would not look to Meyer or any other reference dealing with the presence or absence of air or moisture to solve the problem that he faced and that Meyer is not analogous art; and
- 10) That all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like, so made, are punishable by fine, or imprisonment, or both, under Section 1001 of Title 18, and that such willful false statements may jeopardize the validity of the application or any document resulting therefrom.
- Further Declarant sayeth naught.


Donald R. Youell, Jr.

RELATED PROCEEDINGS APPENDIX

None.